

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the present Amendment, Claims 8-9 and 23-32 will be all the claims currently pending for the Examiner's consideration. Claims 23-32 have been amended. Applicants respectfully submit that no new matter has been added by the present amendments. Support for the amendments can be found generally throughout the Applicants' disclosure. It should also be noted that this Amendment is not in acquiescence of the Office's position on the allowability of the claims but made merely to expedite prosecution.

The Office is, therefore, respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

I. CLAIM REJECTIONS:

A. 35 USC 112, Second Paragraph

Claims 8 and 23-32 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

Claims 23-32 are amended to depend from Claim 9. As such the present rejections are moot regarding such claims.

Regarding Claim 8, as best understood, it appears the Office's position is that the recitation of "utilized in" is an "intended use," which does not "carry patentable weight." (Office Action, Page 2).

Applicants respectfully submit that the present specification supports an interpretation where the phrase "utilized in" denotes an actual state of use that fundamentally ties "molded rubber bodies" to the physical characteristics of the feature preceding the phrase "utilized in", namely "said rubber vulcanate."

As a result, the disputed claim language reaches well beyond merely describing an intended use. Because the claims actively recite an actual state of use, rather than merely a hypothetical intended use, the same is to be given patentable weight. In addition, the Office Action presented no evidence or reasoning why one of ordinary skill in the art would interpret the phrase "utilized in" as merely denoting an intended use.

Applicants respectfully submit the rejection should now be withdrawn at this juncture.

B. 35 USC 103(a)

Claims 8, 9 and 23-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,127,488 or DE 19701487 to Obrecht et al. in view of U.S. Patent No. 5,232,531 to Dammann et al., JP 57-212239 or JP 05-017630.

As best understood, it is the Office's position that the primary references teach a rubber composition useful for vulcanate production but lacking the addition of a polyisocyanate component. But the secondary references are said to teach such polyisocyanate components; therefore, the combination would be obvious so as to produce rubber compositions having improved moldability and bonding characteristics. Applicants continue to disagree with the Office's assertions.

As explained previously, but perhaps more noteworthy now with respect to Claims 9 and 23-32 which are directed toward specific molded rubber bodies, the combination of Obrecht with Dammann would necessarily produce an adhesive composition containing a tackifying resin, which would be expected to render the same unsuitable as a molded body (e.g., cable sheaths, hoses, drive belts, conveyor belts, roller coverings, tire components, shoe soles, gaskets, damping elements and membranes). In other words, it would have been unexpected to one of ordinary skill in the art that a molded body produced in accord to the combination of the teachings of Obrecht with Dammann would not have adhesive properties. As such, there is clear evidence of the unexpected and non-obviousness nature of Applicants' claimed invention.

Similarly, the combination of Obrecht and JP '630 and/or the combination of Obrecht and JP '239 also fail to teach or suggest the claimed vulcanates utilized in molded rubber bodies or the claimed molded rubber bodies *per se*.

As was the case with Dammann, JP '630 is directed to adhesive compositions which would be expected to render the combination with Obrecht unsuitable for the production of the claimed molded rubber bodies.

With respect to JP '239, Applicants again note, that while JP '239 appears to disclose rubber compositions with high dynamic modulus, JP '239 does not provide any teaching or suggestion that the polyisocyanate component is responsible for this increased property due to the presence of the other components in the rubber composition. For example, in addition to the polyisocyanate, JP '239 discloses that its rubber composition includes, in part, 5-25 parts of unmodified or modified novalac-type phenolic resin. Phenolic resins are well-known to have active hydrogen groups which can react with the isocyanate groups on the polyisocyanate. Further, phenolic resins have been used to impart greater mechanical strength (see e.g., U.S. Patent No. 5,965,671). Hence, the skilled artisan would not have attributed the higher dynamic modulus to the presence of the phenolic resin and, therefore, would have found the claimed molded rubber bodies to be unexpected in view of the combination of the polyisocyanate of JP '239 with the rubber composition of Obrecht.

For the aforementioned reasons, Applicants respectfully assert that the claims are not obvious over the cited references and, therefore, the withdrawal of the rejections is requested.

II. CONCLUSION

In view of the foregoing, it is respectfully submitted that Claims 8-9 and 23-32 fully distinguishable over the applied art and are thus in condition for allowance. Notice to the effect is earnestly solicited.

If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

The USPTO is hereby authorized to charge any fees, including any fees for an extension of time or those under 37 CFR 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

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